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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,422	03/22/2001	Satoru Suzuki	09812.0161-00000	4553

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EXAMINER	
COLBERT, ELLA	

ART UNIT	PAPER NUMBER
3696	

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07/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/815,422	SUZUKI ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 30-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 30-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/30/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 and 30-33 are pending. Claims 1, 30, and 32 have been amended in this communication filed 04/10/08 entered as Response After Non-Final Action.

2. The IDS filed 5/30/08 has been considered and entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,347,136) Horan in view of (US 5,956,697) Usui and further in view of (US 6,959,288) Medina et al, hereafter Medina.

Claims 1. Horan discloses, An electronic apparatus comprising:

operation inputting means for designating one of a plurality of functions, including playback, recording, fast forwarding, and rewinding (col. 3, lines 35-60); and

function executing means for executing at least one of the plurality of functions, including playback, recording, fast forwarding, and rewinding, designated by the operating input means (col. 3, lines 35-60).

Horan failed to disclose, measuring means for measuring the time during which each of said functions has been executed by said function executing means. Usui discloses, measuring means for measuring the time during which each of said functions has been executed by said function executing means (col. 4, lines 25-55).

Horan and Usui failed to disclose, computing means for computing an amount of charge based on the execution time measured by said measuring means regarding each of said functions, wherein a time unit charge decreases as the execution time increases and the time unit charge becomes zero when the execution time reaches a predetermined time value; and receiving means for receiving a first key to the electronic apparatus to disable at least one of the plurality of functions, including playback, recording, fast forwarding, and rewinding, if the amount of charge is not settled, and a second key to enable at least one of the plurality of functions, including playback, recording, fast forwarding, and rewinding, if the amount of charge is settled. Medina discloses, computing means for computing an amount of charge based on the execution time measured by said measuring means regarding each of said functions, wherein a time unit charge decreases as the execution time increases and the time unit charge becomes zero when the execution time reaches a predetermined time value; and receiving means for receiving a first key to the electronic apparatus to disable at least one of the plurality of functions, including playback, recording, fast forwarding, and rewinding, if the amount of charge is not settled, and a second key to enable at least one of the plurality of functions, including playback, recording, fast forwarding, and rewinding, if the amount of charge is settled (col. 18, line 25-col. 22, line 12, col. 44, lines 33-59, col. 47, line 65-col. 50, line 5, col. 55, line 52-col. 56, line 25 and fig.'s 1A-1D, 2-4, 6, 9, and 10 –shows keys that can be used to disable functions or enable functions). In treatment of the last limitation quoted above regarding a chargeable amount computing means computes said chargeable amount based on the execution

time regarding each of said functions and through weighting on a function-by-function basis. It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to know how much time has been spend using each function and to know the amount of expected payment based on the charge for each function.

Claim 2. Horan and Medina failed to disclose, An electronic apparatus according to claim 1, wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting on a function-by-function basis. Usui discloses, An electronic apparatus according to claim 1, wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting on a function-by-function basis (col. 2, lines 15-51). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to calculate the fee for access according to the length of time each device is connected to the client or other network device.

Claim 3. Horan and Medina failed to disclose, An electronic apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting by a load factor of said microprocessor in effect during execution of each of said functions. Usui discloses, An electronic apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said computing means computes said amount of charge based on the execution time regarding each of said functions and through weighting by a load factor of said microprocessor in effect during execution

of each of said functions (col. 3, line 61-col. 4, line 10). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have a microprocessor for loading the devices and be able to charge for the execution of each device by an account charging unit.

Claim 4. Horan discloses An electronic apparatus according to claim 2, wherein said chargeable amount computing means computes said chargeable time based on different weighting factors set for different apparatuses (col. 3, line 61-col. 4, line 15).

Claim 5. Horan discloses An apparatus according to claim further comprising: storing means for storing execution times for each of said functions measured by said measuring means (col. 4, lines 16-57); and transmitting means for transmitting said execution times from said storing means to an external entity for settlement of charges (col. 6, lines 24-36).

Claim 6. Horan and Medina failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the amount of charge computed by said computing means; and transmitting means for transmitting said chargeable time from said storing means to an external entity for settlement of charges. Usui discloses, An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the amount of charge computed by said computing means (col. 4, lines 5-10 and col. 5, lines 16-53); and transmitting means for transmitting said chargeable time from said storing means to an external entity for settlement of charges (col. 3, lines 26-49). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by

Usui to have a fee-charging server that checks the access time of each device and stores the amount of time for later reconciliation of the amount of the charge (fee).

Claim 7. Horan and Medina failed to disclose, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus; and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means. Usui discloses, An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus (col. 2, lines 24-43 –Summary of Invention); and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means (col. 1, lines 49-67-Background of the Invention). It would have been obvious to one having ordinary skill in the art to modify Horan as taught by Usui to have the capability to settle the account by performing a mathematical process to arrive at an account settlement for each function's usage.

Claim 30. This independent claim is rejected for the similar rationale as given above for claims 1 and 6.

Claim 31. This dependent claim is rejected for the similar rationale as given above for claims 5 and 6.

Claim 32. This dependent claim is rejected for the similar rationale as given above for claims 1-3.

Claim 33. This dependent claim is rejected for the similar rationale as given above for claim 6.

Response to Arguments

Applicant's arguments filed 04/10/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Horan, Usui, and Medina, even if combined as suggested by the Examiner, fail to teach or suggest at least the claimed "computing means" and "receiving means" has been considered but is not persuasive. Response: The computing means is interpreted as being in col. 48, line 37-col. 49, line 7 and line 42-col. 50, line 5 in Medina. A computation has take place in order for the recipient to be billed for the usage time and a receiving means has to be present in order for the end-user to receive the electronic digital content and the encryption/decryption keys. Col. 66, lines 51-56 discusses a delivery means (receiving means) in Medina.

Issue no. 2: Applicants' argue: The cited passage in Medina does not teach or suggest the claimed "computing means for computing an amount of charge "wherein" "a time unit charge decreases as the execution time increases and the time unit charge becomes zero when the execution time reaches a predetermined time value", as recited in claim 1 has been considered but is not persuasive. Response: First, the following examples of language in a claim that may raise a question as to the limiting effect of the language in a claim are: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses. The list of examples is not intended to be exhaustive." MPEP 2106 II C. Second, "a recitation

directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform." MPEP 2114 and *Exparte Masham*, 2 USPQ2d 1647 (1987). Third, "while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone." MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Fourth, it is well-known from a mathematical stand point that a time unit charge decreases as the amount of time of usage increases and the charge eventually becomes zero. "A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1285, 1391 (2007). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." Id. 127 S. Ct. at 1739, 82 USPQ2d at 1395. Also, "when a work is available in one field of endeavor, design incentatives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, 103 likely bars patentability." Id. 127 S. Ct. at 1740, USPQ2d at 1396.

Issue no. 3: Applicants' argue: According to Horan, Usui, and Medina fail to establish a prima facie case of obviousness with respect to claim 1, claims 2-7, and 30-33 are allowable for at least the same reasons as for claim 1 has been considered but is

not persuasive. Response: The Examiner disagrees that claims 1, 2-7 and 30-33 are allowable. The claims are not in condition for allowance at the present time as discussed above in the responses to Applicants' arguments. Resort can be had to case law regarding the rational supporting the motivation for combining references as follows: "We have noted that evidence of a suggestion, teaching, or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved". *In re Dembiczak*, 50 USPQ2d 1614. Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988). "Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to our precedent which holds that for the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references." See, e.g., *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

July 14, 2008